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Intellectual Property Administration
P.O. Box 272400
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EXAMINER

CHACE, CHRISTIAN

ART UNIT	PAPER NUMBER
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2187

DATE MAILED: 02/17/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,720

Applicant(s)

SPENCER ET AL.

Examiner

Christian P. Chace

Art Unit

2187

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 January 2004 has been entered.

Response to Amendment

This Office action has been issued in response to amendment filed 12 January 2004 with the instant Request for Continued Examination. Claims 1-18 and 20-33 are pending. Applicants' arguments have been very carefully and respectfully considered, but they are not persuasive. As the instant Office action is a first action on merit following an RCE, and it has NOT been made final.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, all of the limitations of claims 2-16, 18, and 20-33 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 31 and 33 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 31 and 33 recite the limitation, "wherein the information about usage of the memory card comprises a measurement of how full the memory card is." Claims 30 and 32, upon which the instant claims depend, recite the same limitation with another, and the claim, as discussed below with respect to the prior art rejection of same, is anticipated by the same citation in the cited prior art of record, as the other limitation is recited as an either/or format as "at least one of." Therefore, claims 31 and 33 do not further limit the subject matter of the previous respective claims upon which they depend.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17 and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimizu et al (US Patent Application Publication #2002/0107832).

Examiner notes that all claims have been interpreted given their broadest reasonable interpretation, as 35 USC 112, 6th paragraph has not been invoked by an explicit recitation of “means-plus-function” limitations. In other words, as in independent claim 16, for example, “a component for” is recited. This phraseology does not invoke 35 USC 112 6th paragraph interpretation as it is not explicitly “a means for.”

With respect to independent claims 1 and 16, a method and system for storing memory card usage information on a memory card is disclosed in the title as an apparatus and method for outputting control information. Examiner interprets “information about usage of the memory card” to be any data that has to do with how the memory card is used. A memory card is disclosed in paragraph 59 as control information storage unit, #726 in figure 1.

Collecting information about the usage of the memory card is disclosed in paragraph 61 as generating use condition information and billing information, as well as advertisement usage information (which is based on the content selected and stored on the memory card – see paragraph 65, for example), which is also stored in control information storage unit 726, as discussed in paragraph 67.

Recording the information about usage of the memory card in an area of the memory card is disclosed in paragraph 61 as the generated use condition information and the billing information being recorded in the control information storage unit 726.

Accessing the information about usage is disclosed in paragraph 61 as, “using the generated use condition information.” If the information is “used,” it is inherently “accessed.”

Examiner notes that claim 16 recites the same limitations as claim 1, except it adds, "a component for..." before each limitation. Examiner notes that as Shimizu et al disclose the method as discussed supra, the "components for" performing that method are inherently disclosed as well.

With respect to claim 2, figure 6 is an example of the generated use condition information, which discloses "number of times reproduction is possible," ("monitoring" write events), "whether copying is allowed," ("monitoring" read events – the data must inherently be read in order to be copied. In other words, if it is not read, it cannot be rewritten as the copy) and "monitoring" power-on events, which is inherent in that if the card collects usage information about the card in an area of the card, as discussed supra with respect to claim 1, then the card must, inherently, be powered on for those transactions, and by "monitoring" the transactions, power-on events are also inherently "monitored." "Monitoring" is interpreted by examiner as the system "being aware" of the transaction. By performing the transaction, the system must, inherently, be aware of it.

With respect to claim 3, the collecting step comprising changing a count associated with an event descriptor when the event occurs is disclosed in figure 9, #S1205. Advertising usage information is "information about the usage of the memory card," as discussed supra with respect to claim 1. Paragraph 98 discloses changing a count as, "updat[ing] the number of accesses to the web (recorded in advertisement usage information)." Access to the web is "the event," and the number of times the web is accessed is the "event descriptor" that counts the number of times the event occurs.

With respect to claim 4, the collecting step further comprising storing a “value parameter” associated with said event descriptor when the event occurs is disclosed in figure 4, and discussed supra, as the “number of times (the website is accessed).”

With respect to claim 5, the collecting step comprising changing a running total, or count, associated with said event descriptor when the event occurs is disclosed in paragraph 98 as discussed supra with respect to claim 3.

With respect to claim 6, recording the information about usage in a dedicated area in said memory card is disclosed in figure 4, for example. Also, this is inherent in that all data stored in a computer memory is in a “dedicated” area – that area is dedicated to whatever data is stored there.

With respect to claim 7, recording the information about usage in a “non-user accessible area” of memory is disclosed in figure 4, and further discussed in paragraph 61 as requiring input by a clerk. As applicants have not discussed which memory might contain a “non-user accessible area,” examiner interprets the memory accessible by the clerk, a “non-user,” as opposed to the owner of the memory card, as that memory. Alternatively, it could be interpreted as the clerk’s memory itself. Either interpretation is anticipated by applicants’ claim language as it stands instantly.

With respect to claim 8, changing a count associated with an event description when the event occurs, and wherein the accessing step comprises displaying the count is disclosed in figure 4, and the “displaying” is discussed in paragraph 62 into 63. Paragraph 62 discusses the use condition information, explained supra with respect to claim 1, for example. Paragraph 63 discusses the fact that the use condition

information contains more particular information, which *shows a user* instruction on how many times the rented digital content may be reproduced, for example. If instructions are being “shown” to a user, they must be “displayed” – this is inherent.

With respect to claim 9, a plurality of event descriptors is disclosed in figure 4. As discussed supra with respect to claim 3, the advertisement usage information contains an “event descriptor,” of which “No. times web site is accessed,” was specifically mentioned. However, figure 4 discloses a plurality of “event descriptors,” such as, “number of times 2nd digital content is reproduced.” Displaying these event descriptors is shown in figure 4, as well, and discussed in paragraph 57 as being provided by advertisement sponsors. Similar to examiner’s interpretation with respect to claim 8, in order to “provide” this information, it would have to be “displayed.” As the descriptor values are provided by the sponsors, they are “selectable.” Upon selection, paragraph 57 goes on to refer to a table, shown in figure 5, which is expressed in figure 4 as a “second [content] identifier.”

With respect to claim 10, the “displaying” step being performed at a “host” is disclosed in paragraph 61, as, “by a clerk.” Also, as “displaying” is discussed supra with respect to claim 9, by the advertisers.

With respect to claim 11, displaying real-time information about usage in a window on a screen at a host is disclosed in paragraphs 61 and 63 as well, as being input by a clerk. In other words, the clerk/user has to see what he/she is entering or being shown, as disclosed supra with respect to claims 8 and 9. Also, paragraph 89

discusses usage of the monitor unit 753 from figure 1, and how it displays information based on the second digital content.

With respect to claim 12, creating “write and read commands” allowing the host to store the information about usage and read that information is disclosed in paragraph 61. Write and read commands are inherent in write and read operations such as “record,” “input,” and “display” or “show”.

With respect to claim 13, changing a count associated with an event descriptor when the event occurs is disclosed as discussed supra with respect to claim 3.

Comparing the count to a threshold, and if the threshold is equaled or exceeded, then causing a message to be sent is disclosed in paragraph 10, with the “message to be sent” being “specifying a digital content identifier.” The threshold is the “certain number or more of second identifiers.”

With respect to independent claim 14, computer readable storage is disclosed in figure 1, #726.

The storage containing at least one event descriptor about the usage of the memory card is disclosed in figure 4 as advertisement usage information.

A count representing the number of occurrences of that event is disclosed in figure 9, #S1205. Advertising usage information is “information about the usage of the memory card,” as discussed supra with respect to claim 1. Paragraph 98 discloses changing a count as, “updat[ing] the number of accesses to the web (recorded in advertisement usage information).” Access to the web is “the event,” and the number

of times the web is accessed is the “event descriptor” that counts the number of times the event occurs.

With respect to claim 15, an amount of memory being used by an aggregation of events corresponding to respective each of the event descriptors (see supra) is inherent – if data of any kind is to be saved, there must be a place to save it. Also, figure 5 shows a table that relates to the 2nd content identifier of figure 4, as also discussed supra with respect to claim 9. In other words, figure 5 is a table that represents an amount of memory being used by an aggregation of the events corresponding to the respective content identifier (2nd content identifier).

With respect to independent claim 17, collecting information about usage of a portable memory card in an electronic device is disclosed in paragraph 61 as generating use condition information and billing information, as well as advertisement usage information (which is based on the content selected and stored on the memory card – see paragraph 65, for example), which is also stored in control information storage unit 726, as discussed in paragraph 67.

Recording the information about usage of the memory card in an area of the memory card is disclosed in paragraph 61 as the generated use condition information and the billing information being recorded in the control information storage unit 726.

With respect to claim 20, collecting information further comprising counting a number of times an image file was written to the memory card is disclosed in paragraph 2, as reproducing image data, which, as shown in figure 4, is counted as the number of

times the digital content may be reproduced (whether that digital content is image data or otherwise, it is still digital, and will be counted).

With respect to claim 21, the collecting information further comprising counting a number of times music files (audio data) were written to the memory card is disclosed in paragraph 2, as reproducing audio data, which, as shown in figure 4, is counted as the number of times the digital content may be reproduced (whether that digital content is audio data or otherwise, it is still digital, and will be counted).


With respect to claim 22, the collecting information further comprising tracking a number of times the memory card is formatted is disclosed in paragraph 61, as the user information is input by the clerk when the user first becomes a member of the rental store. The rental price (billing information) is calculated using the generated use condition information. Therefore, if the "format" changes, i.e., a different order is placed, so does the billing information, which is inherently "tracked," as it must be in order to "bill" the user.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Himoto et al (US Patent #6,478,679).



With respect to independent claim 23, examiner must first point out that “storing the usage of the memory card on the memory card” has been interpreted as storing the usage of the memory card *in* the memory of the card. Also, “usage of the memory card” is very broad, and may comprise any number of things, for example, as discussed supra with respect to claim 1. In this case, examiner has interpreted “usage of the memory card” as the type of games stored and the respective scores, for example, as shown in figure 7, 8A, and 8B, as they are activities stored on the card that are used by the card.

These figures also show a portable memory card, as discussed in the abstract.

As storing the usage activities is shown as discussed supra, inherently those activities are “monitored” if they are stored. For example, the score is recorded with the game title. Therefore, the game is “monitored” by keeping track of the score.

Displaying the usage activity on the memory card is shown in figure 3 as a LCD. This is also discussed in the abstract, for example.

With respect to claims 24-25, displaying the usage IN a window on the memory card or on a screen on the memory card are disclosed, as discussed supra, in figures 7 and 8, which show LCD 14 of figure 3, discussed supra with respect to claim 23.

With respect to claim 26, monitoring the amount of remaining free space on the memory card is disclosed in figures 5 and 6 as “Empty Region.”

With respect to independent claims 28 and 29, a system and method for storing memory card usage information on a memory card is disclosed in the abstract and title as a memory device, controller, and electronic device which allows games to be saved o the memory device.

Collecting information about usage of the memory card is disclosed in figures 7, 8A, and 8B, for example. "Usage of the memory card," is interpreted by examiner to mean the games played using the memory card, #10. The information collected are the games.

Recording the information about usage of the memory card in an area of the memory card is also disclosed in figures 7, 8A, and 8B, for example. As discussed in column 12, lines 37-38, a list of stored data is shown. The data being stored, or recorded, on the memory card 10 is discussed in column 12, line 49.

Accessing the information about usage of the memory card from the memory card is disclosed in column 12, lines 44-46, the particular game is selected, thereby accessing the information about the usage of the memory card.

Displaying the information about the usage of the memory card on a screen on the memory card is disclosed in column 12, lines 37-38, which displays a menu of the information about the usage of the memory card on an LCD screen.

Examiner notes that claim 28 is a method claim that is anticipated by the instantly cited prior art of record. Accordingly, apparatus to perform the anticipated method is also anticipated, as discussed supra with respect to claims 1 and 16.

With respect to independent claims 30 and 32, Collecting information about usage of the memory card is disclosed in figures 7, 8A, and 8B, for example. "Usage of the memory card," is interpreted by examiner to mean the games played using the memory card, #10. The information collected are the games.

Recording the information about usage of the memory card in an area of the memory card is also disclosed in figures 7, 8A, and 8B, for example. As discussed in column 12, lines 37-38, a list of stored data is shown. The data being stored, or recorded, on the memory card 10 is discussed in column 12, line 49.

Accessing the information about usage of the memory card from the memory card is disclosed in column 12, lines 44-46, the particular game is selected, thereby accessing the information about the usage of the memory card.

The information about usage of the memory card comprising at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card is discussed in column 10, lines 64-67, as shown in figures 5A-E and 6A-C, for example, which shows how full the memory card is. As applicants have not claimed whether this is a quantitative or qualitative measurement, examiner has interpreted the display of the figures to be a qualitative measurement, as the user can see about how much of the memory is full. Examiner notes that the instant claim language of "at least one of," merely requires one of the two possible limitations to be anticipated to anticipate the entire limitation.

Examiner notes that claim 30 is a method claim that is anticipated by the instantly cited prior art of record. Accordingly, apparatus to perform the anticipated method (claim 32) is also anticipated, as discussed supra with respect to claims 1 and 16.

With respect to claims 31 and 33, the information about usage of the memory card comprising a measurement of how full the memory card is disclosed as discussed supra with respect to claims 30 and 32, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al (cited supra) and Bueno (US Patent # 5,532,689).

Shimizu et al disclose the subject matter of the claims upon which the instant claim depends.

Shimizu et al disclose collecting information.

The difference between Shimizu et al and the instant claim is the information collected further comprising counting physical insertions of the memory card in the electronic device.

Bueno discloses counting the number of times a memory card is inserted into an electronic device in the abstract as an access count.

Accordingly, it would have been obvious to one of ordinary skill in the art having the teachings of Shimizu et al and Beuno before him/her, to utilize the access counting of Bueno in the system of Shimizu et al as the access counting allows fraud prevention, as discussed by Bueno in column 3, lines 20-25.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Himoto et al (cited supra) and No (US Patent #6,587,140).

Himoto et al disclose the subject matter of the claims upon which the instant claim depends.

Himoto et al disclose providing a portable memory card in a digital video game system.

The difference between Himoto et al and the instant claim is the memory card being in a digital camera.

No discloses a memory card for use in a digital camera.

Accordingly, it would have been obvious to one of ordinary skill in the art having the teachings of Himoto et al and No before him/her, to utilize the portable memory card of Himoto et al in the camera of No as it allows for a completely portable, untethered camera design, as disclosed by No in column 1, lines 40-43.

Response to Arguments

With respect to applicants' arguments that Shimizu et al does not suggest collecting information about usage of a memory card, and recording the information about usage in an area of the memory card, examiner respectfully disagrees. Examiner has rendered a more detailed explanation of his interpretation of the instant claim language in the interest of clarifying his position with respect to same. As discussed supra with respect to all of the independent claims, "usage of a memory card" is very broad, and can be interpreted, within its broadest reasonable interpretation, even in light of the specification, as anything that has to do with the use of the memory card.

The same response is maintained with respect to Himoto et al as it applies to the relevant claims as discussed supra.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent #6,489,932 discloses a display device including an integral docking station for a palm-sized computing device.

Sega DreamCast, Visual Memory Unit, Instruction Manual, 1999 discloses a memory card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian P. Chace whose telephone number is 703.306.5903. The examiner can normally be reached on 9-4-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Sparks can be reached on 703.308.1756. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christian P. Chace